

### **REMARKS/ARGUMENTS**

These remarks are submitted responsive to the final office action dated July 22, 2004 (Office Action). As this response is timely filed within the 3-month shortened statutory period, no fee is believed due.

In paragraphs 3-4, claims 1 and 17 have been rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,483,986 to Krapf, *et al.* (Krapf). In paragraphs 5 and 6, claims 2-9 and 18 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Krapf in view of U.S. Patent No. 5,442,390 to Hooper, *et al.* (Hooper).

In response to the Office Action, Applicants have enclosed Declarations under 37 C.F.R. § 1.131 supporting the removal of Krapf as a reference. The Declarations are accompanied by a copy of the Applicants' Confidential Invention Disclosure No. BOC8-1999-0105 (Disclosure) entitled "User Controlled, Multi Device, Media On Demand - System, Method, Service and Business Model." The Disclosure and Declarations demonstrate proof of conception for the claimed subject matter of the Applicants' invention at least as early as October 6, 1999, which predates the effective date of Krapf (May 26, 2000).

The Disclosure is a completion of an International Business Machines Corporation (IBM) confidential disclosure form, which is a standardized document utilized by the IBM and submitted by the inventors upon conception of an invention. The document management system under which the IBM confidential disclosure form has been generated does not permit amendments to be made to the Disclosure once the Disclosure has been completed. Any changes and/or additions are appended as an attachment to the IBM confidential disclosure form together

with the date the attachment was added. No such attachment accompanies the Disclosure, signifying that the Disclosure has not been amended since October 6, 1999.

The IBM confidential disclosure form provides all information necessary for outside legal counsel to prepare an appropriate patent application relative to the disclosed invention when used in conjunction with information known by one of skill in the art. The present application, including each claim within the present application, has been prepared based upon the Disclosure. Further, as noted in the enclosed Declarations, prior to submission of the application to the USPTO, the inventors review the application to insure that the claims and material contained therein are fully supported by the Disclosure.

Applicants further exercised due diligence from prior to the effective date of Krapf until September 29, 2000, the filing date of the instant application. In regard to diligence, as set forth in the Declarations, once an IBM invention disclosure form is completed, the disclosure is reviewed by an invention review board within IBM to determine whether to prepare an application based upon the submitted disclosure. Upon reaching a decision to prepare an application, outside counsel is selected to prepare the application, instructions in this regard, together with the IBM invention disclosure form, are conveyed to the outside counsel. The outside counsel prepares a draft of the application that is iteratively reviewed by each inventor until such time that the inventors are satisfied that the application sufficiently details the inventive concepts detailed in the disclosure, at which time the application is expeditiously filed with the USPTO.

Since Applicants conceived of the present invention before the effective date of Krapf and exercised due diligence in constructively reducing the invention to practice between the date

of the Disclosure until the filing date, as supported by the enclosed Declarations, Krapf should be withdrawn as a reference for purposes of 35 U.S.C. § 102(e) and 35 U.S.C. § 103(a), which action is respectfully requested. Withdrawal of Krapf as a reference results in a withdrawal of the rejections with respect to claims 1-9, 17, and 18.

Applicants believe that this application is now in full condition for allowance, which action is respectfully requested. The Applicants request that the Examiner call the undersigned if clarification is needed on any matter within this response, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

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